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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/927,050	08/09/2001	Ryosuke Takeuchi	450100-03410	4114

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EXAMINER

TRAN, HENRY N

ART UNIT	PAPER NUMBER
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2629

DATE MAILED: 10/17/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>		<b>Applicant(s)</b>	
	09/927,050		TAKEUCHI, RYOSUKE	
	<b>Examiner</b>		<b>Art Unit</b>	
	Henry N. Tran		2629	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 08 August 2006.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 8/8/06 has been entered. Claims 1-21 are pending in this application.

### ***Response to Arguments***

2. Applicant's arguments with respect to claims 1-6 have been considered but are moot in view of the new ground(s) of rejection.

### ***Drawings***

3. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the “a reproduction unit” (claim 7) and “a editing unit” (claim 8) must be shown or the features canceled from the claims. No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as “amended.” If a drawing figure

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is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 4-10 and 15 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Each of the claims 4-10 and 15 recites at least one limitation that is found lack of antecedent basis for the limitation in the claim. For example:

Claim 4: on line 4, "said portions of information". ("portions" should be changed to --portion--).

Claim 5: on line 9, "said operation portion". ("portion" should be changed to --unit--).

Claim 6: on line 5, "said operation portion". ("portion" should be changed to --unit--).

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Claim 7: on line 4, "said portion of information". ("information" should be changed to --the information--).

Claim 8: on line 3, "portions of information". ("portions of information" should be changed to --the portion of the information--).

Claim 9: on line 3, "said operation portion". ("said operation portion" should be changed to -- said operation unit--).

Claim 10: on line 3, "said operation portion". ("said operation portion" should be changed to -- said operation unit--).

Claim 15: on line 6, "said four markers". ("said four markers" should be changed to -- said four marks--).

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1-6 and 9-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Inoue et al (U.S. Patent No. 6,332,024, hereinafter referred to as "Inoue") in view of Seidensticker, Jr. et al (U.S. Patent No. 6,128,012, hereinafter referred to as "Seidensticker, Jr.").

Regarding claims 1-6, 9 and 10, Inoue teaches a portable communication apparatus (1) comprising: a display unit (2) configured to display information, see figure 1A; a pointer (CB1) specifying one portion of the information, and a mark ("pointing arrowheads, and up/down, left and right arrows IB10, IB11, and IB12) indicating a

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direction said pointer can be shifted, see figure 5B; an operation unit (3, 4A and 4B) configured to be operated by a user; a controller (CPU 10) configured to shift said pointer to a desired position in accordance with an operation of said operation unit, see figure 2; wherein, the operation unit is a dial (3) which is rotated by said user; wherein, the operation unit is a push key (4A or 4B) operated by said user; wherein, the portion of the information are listed in a hierarchy on said display unit, see figure 4A; and the controller is configured to shift said pointer to a desired position an accordance with an operation of said operation unit, see col. 9, lines 3-20.

However, Inoue does not teach or disclose that the controller is configured to “eliminate said mark from the display unit if said pointer can not be shifted in the direction said mark indicates” (claim 1), including: a mark indicating the upper direction (claim 5), or a mark indicating the lower direction (claim 6).

Seidensticker, Jr. teaches a portable communication apparatus (30) comprising a display unit (34), an operation unit (36), and a controller (CPU 50), which is configured to implement a function to select an information item listed in a hierarchy on the display unit, and to eliminate a mark, which indicates the upper direction (an upwardly pointing arrowhead) or the lower direction (a downwardly pointing arrowhead), from the display unit if the item, which can be selected, is currently displayed at the top of the list or at the bottom of the list, see at least figures 1, 2, 6 and 7, and col. 11, line 29 to col. 12, line19.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to implement the function of eliminating a mark as taught by Seidensticker, Jr. in the Inoue system because this would provide an improved user interface capable of

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enhancing the functionality and reliability of the control, selection, and viewing data items displayed on a screen, see Seidensticker, Jr., col. 1, lines 12-18.

By said rationale, claims 1-6 are rejected.

Regarding claims 11-21, which comprise claimed elements and limitations of claims 1-6 and 9-10, and are therefore rejected on at least the same reasons discussed in claims 1-6 and 9-10 above.

8. Claims 7 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Inoue in view of Seidensticker, Jr. (hereinafter referred to as "Inoue-Seidensticker, Jr.") as applied to claim 1 above, and further in view of Yankowski (U.S. Patent No. 6,388,958).

Inoue-Seidensticker, Jr. teaches generally all as discussed above. Inoue further teaches that the controller CPU 10 is configured to reproduce audio data, see figure 2, and col. 6, lines 4-12.

However, Inoue-Seidensticker, Jr. does not teach said portion of information is a title of a song, and a editing unit configured to edit the order of said portions of information on said display unit.

Yankowski teaches a computer system comprising a display/control unit (82), a memory (72), and a controller (68), which are configured to display information, which is a play list of titles of songs, whose orders can be manipulated, deleted, or rearranged, see col. 10, line 55 to col. 11, line 3.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to utilize the editing function as taught by Yankowski in the Inoue-

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Seidensticker, Jr. system because this would an improved user interface capable of enhancing the selection and playing of the song play list displayed on a screen.

By this rationale, claims 7 and 8 are rejected.

***Conclusion***

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Henry N. Tran whose telephone number is 571-272-7760. The examiner can normally be reached on M-F 8:00-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bipin H. Shalwala can be reached on 571-272-7681. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

HT

10/15/06

*Henry N. Tran*

**HENRY N. TRAN  
PRIMARY EXAMINER**